#6/attach.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: David WALLACH et al.

Application No.: 09/927,458 Conf. No. 6865

Filed: August 13, 2001

For: MODULATORS OF THE FUNCTION OF RECEPTORS OF THE TNF/NGF RECEPTOR...

Art Unit: 1635

Examiner: R. SCHNIZER

Washington, D.C.

Atty.'s Docket: WALLACH=22A

Date: May 6, 2002

THE COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Sir:

Transmitted herewith is a [ X ] Amendment [ ] _____
in the above-identified application.

[ ] Small Entity Status: Applicant(s) claim small entity status. See 37 C.F.R. §1.27.

[XX] No additional fee is required.

[ ] The fee has been calculated as shown below:

| | (Col. 1) CLAIMS REMAINING AFTER AMENDMENT | | (Col. 2) HIGHEST NO. PREVIOUSLY PAID FOR | (Col. 3) PRESENT EXTRA EQUALS | SMALL ENTITY RATE | SMALL ENTITY ADDITIONAL FEE | OR | OTHER THAN SMALL ENTITY RATE | OTHER THAN SMALL ENTITY ADDITIONAL FEE |
|---|---|---|---|---|---|---|---|---|---|
| TOTAL | * 14 | MINUS | ** 27 | 0 | x 9 | $ | | x 18 | $ |
| INDEP. | * 1 | MINUS | *** 3 | 0 | x 42 | $ | | x 84 | $ |
| FIRST PRESENTATION OF MULTIPLE DEP. CLAIM | | | | | + 140 | $ | | + 280 | $ |
| | | | | | ADDITIONAL FEE TOTAL | $ | OR | TOTAL | $ |

* If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.

** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 20, write "20" in this space.

*** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 3, write "3" in this space.

The "Highest Number Previously Paid For" (total or independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment of the number of claims originally filed.

[XX] Conditional Petition for Extension of Time

If any extension of time for a response is required, applicant requests that this be considered a petition therefor.

[ ] It is hereby petitioned for an extension of time in accordance with 37 CFR 1.136(a). The appropriate fee required by 37 CFR 1.17 is calculated as shown below:

| Small Entity | | Other Than Small Entity | |
|---|---|---|---|
| Response Filed Within | | Response Filed Within | |
| [ ] First | - $ 55.00 | [ ] First | - $ 110.00 |
| [ ] Second | - $ 200.00 | [ ] Second | - $ 400.00 |
| [ ] Third | - $ 460.00 | [ ] Third | - $ 920.00 |
| [ ] Fourth | - $ 720.00 | [ ] Fourth | - $ 1440.00 |
| Month After Time Period Set | | Month After Time Period Set | |

[ ] Less fees ($_____) already paid for ___ month(s) extension of time on _____.

[ ] Please charge my Deposit Account No. 02-4035 in the amount of $_____.

[ ] Credit Card Payment Form, PTO-2038, is attached, authorizing payment in the amount of $_____.

[ ] A check in the amount of $_____ is attached (check no. ).

[XX] The Commissioner is hereby authorized and requested to charge any additional fees which may be required in connection with this application or credit any overpayment to Deposit Account No. 02-4035. This authorization and request is not limited to payment of all fees associated with this communication, including any Extension of Time fee, not covered by check or specific authorization, but is also intended to include all fees for the presentation of extra claims under 37 CFR §1.16 and all patent processing fees under 37 CFR §1.17 throughout the prosecution of the case. This blanket authorization does not include patent issue fees under 37 CFR §1.18.

BROWDY AND NEIMARK, P.L.L.C.

Attorneys for Applicant(s)

By: _____
ALLEN C. YUN
Registration No. 37,971

Facsimile: (202) 737-3528
Telephone: (202) 628-5197

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231



PLM
Paper Number 18

In re Application of:
Leslie I. Gold, et al.
Serial No. 08/283,857
Filed: August 1, 1994
For: FIBRIN-BINDING PEPTIDES, DNA CODING THEREFOR AND USES THEREOF

DECISION ON PETITION



This is a decision on the petition under 37 CFR 1.181 and 37 CFR 1.144, filed November 4, 1996, to withdraw the restriction requirement with respect to Groups I/II and VI. Note, petitions from restriction requirements are properly considered under 37 CFR 1.144. Therefore, the petition is being treated as a petition under 37 CFR 1.144.

On April 7, 1995, an Office action was mailed that required restriction between claims 1-9 and 13 (Group I), claims 10-12 (Group II), claims 14-15 (Group III), claim 16 (Group IV), claim 17 (Group V), claim 18 (Group VI), and claims 19 and 20 (Group VII). With an election of Group II, applicant was further required to elect one of two patentably distinct species of the invention. In response to the Office action, applicants timely filed a response on August 7, 1995 in which applicants canceled claims 14-17 drawn to Groups III, IV and V, elected Group I, claims 1-9 and 13, and traversed the restriction requirement insofar as the claims of Groups II, VI and VII were deemed to be independent and distinct from the elected invention. On November 28, 1995, an Office action was mailed which withdrew the requirement for restriction between Groups I and II and maintained and reaffirmed the restriction between Groups I/II and Groups VI and VII. In applicants' response filed May 28, 1996, a request for reconsideration of the requirement for restriction with respect to Groups VI and VII was made. On September 4, 1996, a final Office action was mailed which reaffirmed the requirement for restriction. The present petition was filed on November 4, 1996 requesting that the restriction requirement between Groups I and VI be withdrawn as least to the extent of considering claim 5 to be a linking claim so that claim 18 will be considered at the time that claim 5 is allowable.

Petitioner asserts that applicants have conceded that if the protein of claim 5 (from Group I/II) is anticipated or obvious then the antibody of claim 18 (Group VI) would also be obvious as it would be obvious to make an antibody to any known peptide. Thus, petitioner contends that if a patent issues containing a claim drawn to the protein of claim 5, and a divisional application is filed resulting in the issuance of a claim of the scope of claim 18, two patents will have issued drawn to inventions which are not patentably distinct. Absent 35 U.S.C. 121, a double-patenting rejection would have to be made on the antibody claim because it is admittedly obvious from the protein. Thus, petitioner concludes that the restriction requirement between Groups I/II and VI should be withdrawn.

As argued by petitioner, MPEP § 803 is appropriate here where it states:

> If there is an express admission that the claimed inventions are obvious over each other within the meaning of 35 U.S.C. 103, restriction should not be required, *In re Lee*, 199 USPQ 108 (Deputy Asst. Comm'r. For Pats 1978).

The decision in *In re Lee* was based not only on the presence of an admission that the claimed inventions are obvious over each other within the meaning of 35 U.S.C. 103 but also on the fact that the issue of "patentable distinctness" between the two groups was close and the Office policy:

> [T]hat it is important from the standpoint of public interest that no restriction requirements be made which might result in the issuance of two patents for the same invention. The nullification of double patenting as a ground of rejection provided for in the third sentence of 35 U.S.C. 121 imposes a heavy burden on the Office to guard against erroneous requirements for restriction where the claims define essentially the same invention and which if acquiesced in, might result in more than one patent for essentially the same invention with attendant prolongation of patent monopoly.

Here, the Office policy is the same as when *In re Lee* was decided and like in *In re Lee*, the "patentable distinctness" issue between the peptide of Group I/II and the antibody of Group VI is close. Lastly, while the admission in this case does not explicitly state that the antibody is obvious over the peptide "within the meaning of 35 U.S.C. 103", the admission certainly implies this and that is how the admission is hereby interpreted. Therefore, like in *In re Lee*, it is concluded that the public interest is better served by withdrawing the restriction requirement and permitting both inventions to be prosecuted in the same application. At this point it is noted that the fact that there is an admission that the antibody is obvious in view of the peptide but not an admission that the peptide is obvious over the antibody would not change this decision because the Office policy that "no restriction requirements be made which might result in the issuance of two patents for the same invention" would still control.

In conclusion, the petition is granted and the examiner is directed to withdraw the requirement for restriction between Groups I/II and VI. Group VII remains restricted from Groups I/II/VI. The application is being returned to the examiner for appropriate action in a timely manner.

PETITION GRANTED.

Mary C. Lee, Deputy Director
Patent Examining Group 1800



Browdy & Neimark
419 Seventh St., N.W.
Washington, DC 20004